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09/891,014	06/25/2001	Michael D. Crandall	54185USA8B.014	9951

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Office of Intellectual Property Counsel
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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/12/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

ms 4
—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-15 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 5-11 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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1. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention.

2. Claims 5 and 7-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, in claim 5, line 7 the term "polar comonomer" lacks proper antecedent basis and it is believed that applicants should substitute this term for the (meth)acrylamide comonomer which precedes it on line 7 of the claim. In claim 9, which is dependent upon claim 5 the dependent claim is broader in certain aspects, that is, the microspheres are not stated to be "solid" in the dependent claim whereas they are required to be in independent claim 5. In both claims 7 and 9, it is not clear to the Examiner whether "optionally" refers only to the polymeric stabilizer, or also makes the presence of both a surfactant and/or a chain transfer agent optional as well.

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly

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connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 11 is rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for the remaining claims, does not reasonably provide enablement for the entire claimed subject matter of claim 11, which finds support nowhere else in the body of the specification, at least as far as express support is concerned, and no inherent support is also believed to exist or has been pointed out. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

6. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 5 and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by Coopridner et al. -617. Note particularly the Abstract, column 1 lines 21-28, line 51 - column 2 line 2, column 3 lines 1-62, column 4 lines 47-64, column 5 line 33 -

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column 6 line 33, column 7 line 65 - column 8 line 10, Examples 4 and 20.

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coopridner et al. -617, taken individually for claims 5-7 and 9, and in view of Le Fevre for claims 8 and 10. The reference is again relied upon substantially as set forth above, with an obviousness rejection being made for claims 5 and 6 since the reference may teach such a large number of embodiments that it may fail to highlight those embodiments which are believed to constitute an anticipation. Note particularly that the reference teaches an adhesive coated substrate such as paper, the adhesive being an alkyl acrylate-acrylamide microsphere based repositionable adhesive composition which can further contain such elements as initiators, stabilizers and surfactants. Although the reference fails to teach the presence of a chain transfer agent for both claims 7 and 9, the Examiner

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believes that such chain transfer agents are both clearly conventional additives and note that the reference teaches (column 7 lines 65-67) that various other additives can be utilized. Alternatively, the chain transfer agent may well decompose during processing. With respect to the additive set forth in both claims 8 and 10, note that Le Fevre et al. is taught by applicants' specification (page 7) as particularly suitable, and one of ordinary skill, motivated by a desire to improve the stability and performance of his microsphere based adhesive would incorporate the additives taught by the secondary reference (e.g. column 1 lines 13-15, column 8 lines 53-56) to be particularly suitable for forming the desired compositions and solutions thereof. What parameters that may be absent are each believed to be, if not expressly or inherently disclosed, obvious modifications to one of ordinary skill, in the absence of unexpected results.

10. Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Delgado -567 (Delgado -562 is cumulative). The reference discloses (note particularly the Abstract, page 3 lines 33-65, page 4 lines 9-25, page 5 lines 4-45, page 7 lines 25-36, page 8 lines 5-11, lines 27-41, Example 11, Table III) repositionable ^{hollow} pressure sensitive adhesive microspheres formed from, in certain embodiments an alkyl acrylate-acrylamide copolymer (e.g. Ex. 11) coated onto a suitable substrate. The

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reference would appear not to be an anticipation only because of the limitation that "a majority of the microspheres contain at least one interior void having a diameter at least about 10% of the diameter of the hollow microspheres, which is applicants' chosen claim language. However, if the presence of such an interior void structure is not inherent in the hollow pressure sensitive microspheres of the invention, it is believed to be at most an obvious design parameter to the skilled artisan. Note that column 3 lines 45-52 teach that it is possible to vary the range of diameters found in the microspheres over quite a significant range. Note also that while the reference teaches (e.g. column 4 lines 11-25) a slightly different range of proportions of the alkyl acrylate ester and the nitrogen containing polar monomer, this is believed to be an extremely well worked area and the choice of a monomer ratio is believed to be well within the ordinary skill of the art.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be

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reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

September 6, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1900~~
1700

Daniel Zinker